



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,637	12/01/2000	Yen-Jen Lee	M-10529 US	3044

36257 7590 12/01/2004

PARSONS HSUE & DE RUNTZ LLP  
655 MONTGOMERY STREET  
SUITE 1800  
SAN FRANCISCO, CA 94111

EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2144

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/729,637

Applicant(s)

LEE ET AL.

Examiner

Joseph R Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Application claims domestic priority to provisional application 60/169,111, filed 12/06/99. The effective filing date of the application is 12/06/99.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The recitation of the phrase "providing an interface allowing a user to available media objects browse" in claim 22 renders the claim indefinite as it is unclear as to what the Applicant regards as the invention.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 2144

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10, 14, 16-19, 21-25, 30, 33-36, 39-51, 53, 54, 56, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (U.S. Pat. App. Pub. 2001/0042098), hereinafter referred to as Gupta.
7. Regarding claims 1, 39, and 43, Gupta disclosed accepting from a sender associated continuous media at a server (see paragraph [0090]), storing the media at the server (see paragraph [0055]), providing a reference to the stored media in an addressed message and sending the message to a receiver (see paragraphs [0067], [0084], [0096], [0098]), and registering a request from the receiver to access and stream the stored media to the receiver (see paragraph [0098], [0100]).
8. Regarding claims 2, 21, 40, 49, and 44, Gupta disclosed publishing stored media as a web page (see paragraphs [0037], [0098]).
9. Regarding claim 3, Gupta disclosed the use of prerecorded media content (see paragraphs [0006], [0007]).
10. Regarding claim 4, Gupta disclosed the use of streaming media content (see paragraphs [0033]).
11. Regarding claims 5, 41, and 45, Gupta disclosed streaming content in a standard format (see paragraph [0034]). Determining such a format for transmitting media to a receiver as claimed is inherent in the invention of Gupta.
12. Regarding claim 6, Gupta disclosed determining a presentation device of the user through a user-defined property field describing "display type" (see paragraph [0068]).

Art Unit: 2144

13. Regarding claim 7, Gupta disclosed the broad concept of determining a recipient of media's available bandwidth by allowing for display options such as "low resolution", "slow system", or other indications of system capabilities (see paragraph [0051]).

14. Regarding claims 8 and 9, Gupta disclosed the ability to delete an annotation message based on commands from a client (see paragraph [0070]).

15. Regarding claim 10, Gupta disclosed the use of a creation time field to signify when annotation content had expired and should not be displayed (see paragraph [0062]).

16. Regarding claims 14, 42, and 46, Gupta disclosed messaging using limited pre-installed messaging hardware (see paragraph [0103]).

17. Regarding claims 16, 22, 47, 50, 53, and 56, Gupta disclosed providing a user an interface with guided control options allowing a user to configure settings for creating a multimedia message including e-mail text, storing the message, and attaching an access for the multimedia message to the e-mail text as claimed (see paragraph [0075]-[0098]).

18. Regarding claims 17, 23, 35, 36, 48, and 51, Gupta disclosed the use of video application (see paragraph [0127]).

19. Regarding claims 18, 19, 25, 54, and 57, Gupta disclosed the use of both local and remote storage devices (see paragraph [0039]).

20. Regarding claim 24, Gupta disclosed the use of graphical and audio output devices (see paragraph [0043]).

21. Regarding claims 30, 33, and 34, Gupta disclosed the use of functional modules for separate messaging functions as claimed (see paragraph [0039]).

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Celron et al. (U.S. Pat. No. 6,223,213), hereinafter referred to as Celron, and further in view of Gifford et al. (U.S. Pat. No. 6,549,612), hereinafter referred to as Gifford.

24. Celron disclosed a browser-based e-mail system and user interface for audio/video capture. A method of the invention comprised accepting media from a sender (see column 2, lines 19-23) for inclusion into an addressed message intended for a recipient who could view the message and the associated media (see column 7, lines 47-56). Celron disclosed allowing the sender to capture multimedia data such as audio and video using a capture panel interface (see column 1, line 66 through column 2, line 7; column 4, line 65 through column 5, line 14; column 5, lines 24-35). Captured media was published as a web page as a response to a capture (see column 7, lines 28-33). Messaging in this manner was achieved through the use of limited pre-installed messaging hardware, such as thin clients, or more specifically, Internet TV (see column 2, lines 52-60).

Art Unit: 2144

25. While Celron disclosed the ability to capture media for inclusion in an addressed message, Celron did not specifically disclose storing the media on a server and providing a reference to the media in the message for access to the stored media.

26. In a related art of electronic messaging, Gifford disclosed a method and system for providing multimedia messages to a client. A service accepted a media from a sender, which was then stored at the service (see column 8, lines 36-40), created a message with a reference to the server for viewing the multimedia, and sent the message to a recipient (see column 6, line 37 through column 7, line 10). In order to view the associated media, the recipient could use the included reference in the message to perform a request for the media (see column 6, lines 33-35; column 8, lines 55-58). Alternatively, media could be opened automatically once the message was opened (see column 7, lines 11-18). Gifford disclosed determining the preferred format for media playback (see column 8, lines 55-62). A message on the server could also be deleted by a user (see column 7, lines 19-27; column 9, lines 21-25). Gifford disclosed sending notification messages in the event of a deleted message or media (see column 14, lines 3-13).

27. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Celron and Gifford to provide a system for accepting and storing media from a sender, providing a reference to the media in an addressed message, sending the message to recipient, and streaming the stored media to the recipient in response to a request to access the media as claimed. The invention of Celron disclosed a general system for sending messages over a network with

Art Unit: 2144

captured video and audio data. One of ordinary skill in the art would have been motivated to consider for inclusion in the invention of Celron the provision to store captured media and provide a reference to the media in the message as taught by Gifford as it would have kept the size of messages smaller, thus utilizing network resources better (see column 2, lines 48-58), and it provided the recipient a more efficient way of interpreting the media streams (see column 8, lines 16-31). This would have been beneficial in the invention of Celron where the use of thin clients was disclosed (see column 2, lines 52-56).

28. Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack (U.S. Pat. No. 6,505,236), hereinafter referred to as Pollack, and further in view of Celron et al. (U.S. Pat. No. 6,223,213), hereinafter referred to as Celron.

29. Pollack disclosed a method and system for handling e-mail messages across a network. The invention included receiving from a sender an electronic message and attachment file, storing the attachment, creating a reference to the stored attachment in the e-mail message, and sending the message to a recipient (see column 2, lines 11-25; column 2, line 58 through column 3, line 2; column 5, lines 17-26). The recipient could then use the reference to access the stored attachment through a request to the server storing the file (see column 5, lines 51-65). Pollack disclosed that the accessed attachment could be provided in a streaming format to the recipient (see column 5, lines 65-67). Pollack disclosed deleting stored attachments after an expiration time (see column 2, lines 35-38; column 3, lines 3-12; column 6, lines 25-32).



Art Unit: 2144

30. While Pollack disclosed the possibility of creating an addressed messaging with an attachment including a server for storing and presenting streaming data to a recipient user, Pollack did not specifically disclose capturing the data from the sender.

31. In a related art of electronic messaging, Celron disclosed a browser-based e-mail system and user interface for audio/video capture. A method of the invention comprised accepting media from a sender (see column 2, lines 19-23) for inclusion into an addressed message intended for a recipient who could view the message and the associated media (see column 7, lines 47-56). Celron disclosed allowing the sender to capture multimedia data such as audio and video using a capture panel interface (see column 1, line 66 through column 2, line 7; column 4, line 65 through column 5, line 14; column 5, lines 24-35). Captured media was published as a web page as a response to a capture (see column 7, lines 28-33). Messaging in this manner was achieved through the use of limited pre-installed messaging hardware, such as thin clients, or more specifically, Internet TV (see column 2, lines 52-60).

32. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Pollack and Celron to provide a system for accepting from a sender an addressed message and associated media at a server, providing a reference to the media in the message, sending the message to a recipient and streaming the media to the user in response to a request by the recipient, including the provision to capture the data from the sender as claimed. The invention of Pollack in which a sender could send a message and associated media, including streaming media, would have motivated one of ordinary skill in the art to consider ways of

Art Unit: 2144

providing such streaming data for storage at the server. Celron provided teachings on the use of such streaming data in an e-mail system, including the provision for capturing the data from the sender for storage on a server. One of ordinary skill in the art would have been motivated to consider the teachings of Celron as the capturing techniques improved upon media data sizes and transmission times (see column 7, lines 14-27), a problem similarly recognized by Pollack (see column 2, lines 48-58).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tullis et al. (U.S. Pat. No. 5,802,314) disclosed a method and system for sending and receiving multimedia messages including voice captures.

Hales et al. (U.S. Pat. No. 6,288,739) disclosed a video conferencing system.

Fortman et al. (U.S. Pat. App. Pub. 2003/0095643) disclosed a message center for receiving and storing messages from a sender and providing the message to a receiver in a different format.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (571) 272-3925. The fax phone

Art Unit: 2144

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

  
WILLIAM A. CUCHLINSKI, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600